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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VLADIMIR MARIN and
ABBAS RAZAVI

Appeal 2008-2755
Application 10/751,243
Technology Center 3600

Decided: June 19, 2008

Before THOMAS A. WALTZ, ROMULO H. DELMENDO, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

ORDER REMANDING TO EXAMINER

This application is remanded to the jurisdiction of the Examiner as
this appeal is not ready for review for reasons which follow.

We determine the following Factual Findings (FF) from the record in this appeal:

1. A Final Office Action was mailed on Aug. 30, 2006, where claims 1, 3, and 10-12 were rejected under 35 U.S.C. § 102(b) as anticipated by either Kaufmann (US 5,770,752, issued Jun. 23, 1998) or Schertl (US 5,668,230, issued Sep. 16, 1997) (Final Office Action 2);
2. A Notice of Appeal was timely filed on Nov. 30, 2006;
3. An Appeal Brief was timely filed on Jan. 30, 2007, where Appellants stated that “[t]he rejection of the pending claims [claims 1, 3, and 10-12] is appealed” but the grounds of rejection to be reviewed on appeal and arguments are limited to the rejection of claim 10 under § 102(b) over Kaufmann and claims 10 and 12 under § 102(b) over Schertl (App. Br. 2-4); Appellants have not submitted an Amendment canceling claims 1, 3, and 11;
4. In the Examiner’s Answer dated Apr. 30, 2007, the Examiner states that the Appellants’ statement of the grounds of rejection to be reviewed on appeal is “correct” (Ans. 2);
5. The Examiner states that the rejections of claims 1, 3, and 11 under § 102(b) over Kaufmann or Schertl have not been withdrawn but have not been presented for review (Ans. 3);
6. The Examiner rejects claim 10 under § 102(b) over Kaufmann and Schertl and claim 12 under § 102(b) over Kaufmann (Ans. 3);
7. The Examiner states that the rejection of claim 12 under § 102(b) over Schertl has been withdrawn in view of Appellants’ arguments (Ans. 4);

8. Appellants submit a Reply Brief dated Jun. 19, 2007, arguing the merits of the rejection of claims 10 and 12 under § 102(b) over Kaufmann and claim 10 under § 102(b) over Schertl (Reply Br. 2);
9. On Nov. 2, 2007, a Supplemental Examiner's Answer is filed to correct "inadvertent errors" regarding the numbering of claims in sections (6) and (9) of the Answer (Supp. Ans. 2);
10. In the Supplemental Answer, the Examiner states that the grounds of rejection that have not been withdrawn but are not on review include claims 1, 3, 11, and 12 under § 102(b) over Kaufmann and claims 1, 3, and 11 under § 102(b) over Schertl (Supp. Ans. 3);
11. The only rejections presented in the Supplemental Answer are of claim 10 under § 102(b) over Kaufmann and Schertl (Supp. Ans. 3);
12. The Examiner states that the rejection of claim 12 under § 102(b) over Schertl is withdrawn in view of Appellants' arguments (Supp. Ans. 4);
13. On Nov. 27, 2007, Appellants submitted a Supplemental Reply Brief disputing the Examiner's assertion that the rejection of claim 12 under § 102(b) over Kaufmann is not under review (Supp. Reply Br. 1);
14. On Dec. 10, 2007, the Board of Patent Appeals & Interferences returned the undocketed appeal to the Examiner for consideration of the Supplemental Reply Brief of Nov. 27, 2007 (Order 1-2);
15. The Examiner merely "noted" the Supplemental Reply Brief in a letter dated Jan. 9, 2008.

From a consideration and review of these Factual Findings, we remand this application to the jurisdiction of the Examiner to clarify on the record exactly what claims and what grounds of rejection are to be reviewed in this appeal. It appears that Appellants want the rejections under § 102(b) of claim 10 over Kaufmann and claims 10 and 12 under § 102(b) over Schertl to be reviewed (FF 3), contrary to their assertion in the Supplemental Reply Brief (FF 13). Since the rejection of claim 12 under § 102(b) has been withdrawn by the Examiner (FFs 7 and 12), it appears that the only claim left on review is claim 10, and the only rejections for review are of claim 10 under § 102(b) over Kaufmann and Schertl (FF 11). However, the Examiner should clarify this issue, as well as the status of claim 12, since the Examiner has indicated both that the rejection of claim 12 has been withdrawn (FFs 7 and 12) and has *not* been withdrawn but is not under review (FF 10).

Once the Examiner has clarified the claims under review, this application is remanded to the jurisdiction of the Examiner to enter a paper canceling the claims not under review (we assume claims 1, 3, and 11). In the Appeal Brief, Appellants appeal from the final rejection of all pending claims, do not expressly state that claims 1, 3, and 11 are withdrawn from the appeal, but merely state that only the grounds of rejection involving claims 10 and 12 are to be reviewed in this appeal (FF 3). Appellants have not submitted an Amendment canceling claims 1, 3, and 11 (FF 3), and the Examiner did not cancel these claims. This is improper. In an Appeal Brief, an applicant can withdraw an appeal as to some of the rejected claims by an expressed or implied statement. In the case before us, Appellants did not provide an express statement of the withdrawal of claims 1, 3, and 11.

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together with an amendment canceling these claims, but instead limited the appeal to the review of grounds of rejection including only claims 10 and 12. Appellants have not appealed any grounds of rejection including claims 1, 3, and 11, and have not challenged the Examiner's rejection of these claims. Thus, we treat these claims as withdrawn from the appeal and require their cancellation prior to a decision on appeal on the merits. *See Manual of Patent Examining Procedure*, § 1215.03 (8th ed. Rev. 6, Sep. 2007) and *Ex parte Ghuman*, <http://des.uspto.gov/Foia/RetrivePdf?system=BPAI&flNm-fd20081175-05-01-2008>, slip opinion at 4-6 (BPAI May 1, 2008)(precedential)(“when an applicant no longer wishes to pursue in the appeal brief rejected claims ..., the applicant should file an amendment canceling any claim which the applicant no longer wishes to pursue.”).

ORDER

This application is remanded to the jurisdiction of the Examiner for actions consistent with the above remarks.

Upon clarification of the rejections and claims under review in this appeal, and entry of a paper canceling the claims not under review, the application should be returned to the Board for consideration of the appeal on its merits as to the remaining claims.

REMANDED

tf/ls

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